

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants acknowledge with appreciation the Examiner's indication that certain claims are allowable in substance. At this time, Applicants have placed claim 25 in independent form. Applicants have also added new claims 31-52, which are dependent on claim 25, and have the scope of claims 2-23, respectively. Applicants do not believe either the amendments to claim 25 or claims 2-23 introduce new matter. In view of the foregoing, Applicants submit that claims 25-52 are immediately allowable. An early notice that these claims have been allowed is earnestly solicited.

Claims 1, 2, 12, 13, 19, and 21-24 were rejected under 35 USC § 102(b) as being anticipated by Scheibelhoffer et al., U.S. Patent No. 5,670,561.

Claims 1, 2, 9 and 21-24 were rejected under 35 USC § 102(b) as being anticipated by Takahashi et al., U.S. Patent No. 4,234,466.

Claims 1, 2, 6, 8, 9, 11, 12, 15, 19, 20 and 22-24 were rejected under 35 USC § 102(b) as being anticipated by EP 116666 taken in view of the evidence of Thomm et al., U.S. Patent No. 3,846,507, and Login, U.S. Patent No. 4,098,741.

In response to *all three* anticipation rejections, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.* Central to each of these rejections is the Examiner's conclusion that:

"Given that the resin contains both hydrophobic monomer and hydrophilic monomer that are present in [the same] ratio as presently claimed, it is clear that the resin will *inherently* be soluble in both water and organic solvent as presently claimed."

Respectfully, this is incorrect, and, if this rejection is maintained, Applicants respectfully request that the Examiner provide some documentary evidence in support thereof. Solubility in water or organic solvent is not wholly dependent upon the ratio of hydrophobic monomer and hydrophilic monomer. Consequently, it is not necessarily the case that any resin that has the same ratio of hydrophobic monomer and hydrophilic monomer as in the instant claims will necessarily be soluble in both water and organic solvent, as required by the instant claims. The prior art apparently recognizes this. Thus, for example, Scheibelhoffer optionally includes surfactants in

his color concentrates, presumably to aid with water solubility where this is a problem. See, for example, Scheibelhoffer at column 7, lines 63 ff. In any case, there is no support on the current record for the Examiner's position regarding inherency, which is crucial to all three anticipation rejections. Therefore, Applicants request that the Examiner reconsider and withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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